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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,870	07/16/1999	ROBERT D. WILSON	BL01134-012	5681
8698	7590	12/23/2004	EXAMINER	
STANDLEY LAW GROUP LLP 495 METRO PLACE SOUTH SUITE 210 DUBLIN, OH 43017			FISCHETTI, JOSEPH A	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/354,870

Applicant(s)

WILSON ET AL.

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12, 15, 17, 18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 15, 17, 18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/21/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11,12,14,15,17-21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 11, lines 6 and 7, the step of providing a singular third party spending vehicle is recited but in lines 9-10 it is recited that there are a plurality of third party providers. Which is it, singular or plural?

Claim 12 is an improper attempt at a Markush grouping.

Claim 20 depends upon a cancelled claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 12, 17, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Longfield.

Longfield 523 discloses a method of providing an income tax refund amount to a taxpayer, comprising: obtaining electronic tax return data from an electronic tax preparation system, said electronic tax return data comprising an income tax refund amount from a taxing authority payable to a taxpayer (col. 3 lines 2-4 disclose electronic

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tax preparation, tax refund to payer is inherent to tax obligations); providing a third party spending vehicle provider (read as the RAL check or RAL credit card, col. 6 lines 30-36) that provides to said taxpayer a spending vehicle in exchange for an assignment of at least a portion of said income tax refund amount; and assigning at least a portion of said income tax refund amount to said third party spending vehicle (for the RAL check to issue, collateral in the form of the tax refund amount must be taken which by agreement involves an assignment of such refund). Longfield, further discloses transferring electronically said at least a portion of said income tax refund amount to an account for said third party spending vehicle (col. 5 lines 53 et seq. disclose transferring the tax refund of a person to whom a RAL check has been issued to an ACH account owned by the RAL).

Longfield also discloses selecting at least one dedicated spending vehicle from at least one spending vehicle provider (sic), said selection completed by said taxpayer (the selection of the spending vehicle read is the choice between the RAL credit card or the RAL check); providing said spending vehicle to said taxpayer in said at least a portion of said tax refund amount assigned to said at third party spending vehicle provider (col. 6 RAL amount due is used as collateral to secure the credit card and hence is provide to the spending vehicle), said spending vehicle for use at a participating outlet (credit card is used at those store which honor them e.g. Visa of MC.

Re claim 12: RAL credit card is the spending vehicle.

Re claim 17: the federal taxing authority is read as the IRS in col. 6 line 24.

RE claim 18: col. 3; line 26 discloses the use of a tax return preparer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11,15,20,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longfield in view of CREDIT CARD NEWS "Marketing Discover Card".

Longfield does not disclose a credit card which has a limit in excess of the collateralized amount nor one which is a retailer. CREDIT CARD News discloses taking a given refund amount e.g. the cash back bonus and creating a spending vehicle which is of double value as provided by a retailer. It would be obvious to modify the credit card in Longfield to both have a increased value feature and be one provided by a retailer e.g. LOWES if the person is a home improvement person, etc., because the motivation for this would be to allow the user to shop where he/she likes to shop and give them a value added benefit for that.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to PRIMARY EXAMINER Joseph A. Fischetti at telephone number (703) 305-0731.



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